

No. 12633.

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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DAY-BRITE LIGHTING, INC., a corporation, .  
*Plaintiff-Appellant,*  
*vs.*

RUBY LIGHTING CORPORATION, a corporation,  
*Defendant-Appellee.*

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## REPLY BRIEF FOR PLAINTIFF-APPELLANT.

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## REPLY BRIEF FOR PLAINTIFF-APPELLANT.

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This brief is in reply to "Brief for Appellee." The chief points raised by defendant in such brief are answered herein *seriatim*.

### Summary of Argument.

A. THE TWO DESIGN PATENTS IN SUIT ARE INFRINGED.

1. That Various Appearance Features of a Patented Device May Also Perform a Useful Function Does Not Exclude Such Features From Forming Part of the Design Thereof.
2. The Design Patents in Suit Are Not Limited in Scope by File-Wrapper Estoppel.
3. No Limited Construction of the Design Patents in Suit Is Required by the Prior Art.

B. IT IS UNFAIR COMPETITION TO COPY THE APPEARANCE OF AN ARTICLE NOT DICTATED AND FROZEN BY MECHANICAL AND USE REQUIREMENTS WHERE SUCH APPEARANCE HAS ACQUIRED A SECONDARY MEANING.

1. Defendant Has Duplicated Numerous Features of Plaintiff's Fixture Which Are Not Dictated by Requirements of Use.
2. The Appearance Features of Plaintiff's Fixture Have Acquired a Secondary Meaning.
3. No Proof of Actual Confusion or Damages to Plaintiff Need Be Presented to Establish Unfair Competition.

C. DEFENDANT HAS NOT ESTABLISHED ANY SPECIAL CIRCUMSTANCES ENTITLING IT TO ATTORNEYS' FEES.

D. CONCLUSION.

## ARGUMENT.

A. The Two Design Patents in Suit Are Infringed.

Defendant has sought to avoid infringement of the design patents in suit by ascribing functionality to the many features of plaintiff's lighting fixture which it has directly appropriated and by limiting the patents in scope to coverage of only the few minute details which differentiate the accused fixture from the design shown in the patents in suit. No such limitation in the scope of the patents is warranted by the file histories of the patents, the prior art, or the nature of the elements forming the patented fixture.

1. That Various Appearance Features of a Patented Device May Also Perform a Useful Function Does Not Exclude Such Features From Forming Part of the Design Thereof.

Defendant asserts that except for the round bead on the bottom of the V-shaped louver in Patent No. D-143,641 and zig-zag end design in Patent No. D-138,990, the balance of the features is functional and not subject to design patent coverage. (Deft. Br. pp. 6-11.)

That the design patents may not be properly limited to include only those parts or elements which are devoid of utility is well established. In the frequently-cited decision of *Ashley v. Weeks-Numan Co.*, 220 Fed. 899 (C. C. A. 2, 1915), the rule is stated, page 901:

“ . . . In a design patent the appearance is the subject-matter of the patent, and the appearance is none the less patentable because a mechanical function is involved. The patentability of a design is determined by its appeal to the eyes, and not by the presence or absence of a mechanical function.”

2. The Design Patents in Suit Are Not Limited in Scope by File-Wrapper Estoppel.

Defendant asserts that Patent No. D-143,641 is limited by its file history to the use of a V-shaped louver having a longitudinal bottom bead of circular cross section, made of specular metal and having notches in the upper edges of their cross louvers or baffles. Patent No. D-138,990, it is contended, is similarly limited to the particular zig-zag ornamentation on the end of the device. (Deft. Br. pp. 12-15.)



Defendant also insists that the scope of the invention be whittled down by the requirement that each of these so-called limitations be found in the infringing article, a practice which has been repeatedly frowned upon by the courts and was recently condemned by the Supreme Court in *Graver Tank & Mfg. Co., Inc. v. The Linde Air Products Company*, 94 L. Ed. 767 (Advance Opinions).

The statement made by applicants Biller and Kaepfel during the prosecution of Patent No. D-143,641 regarding the basic similarity of the "Challenger" fixture and the fixture of their invention [R. 327] merely conceded that the "Challenger" fixture included the general *mechanical* arrangement of the applicants' invention but did not concede design similarity or identity.

Never, at any time during the prosecution of Patent No. D-143,641, did the applicants limit their contribution to the longitudinal bead on the bottom of the V-shaped louver. As a matter of fact, applicants repeatedly stressed the fact that their contribution lay in a fixture which included ". . . a wide V-shaped central longitudinal louver with downwardly converging sides" [R. 330]. *Any references made to the longitudinal bead did not partake of the nature of limitation but of description.*

The contention that the patentees limited the use of the invention to "specular metal" is based upon references made by the applicants to a copending mechanical application in which the use of such metal was disclosed. In the design application, applicants did not limit the use of the invention to any particular material but indicated that the appearance features of the device would be *enhanced* by the use of such a material.



As indicated previously, applicants repeatedly stressed the shape of the V-shaped central louver and the single statement during the prosecution of the application regarding the “notched upper edges” of the cross louvers was merely intended to point out an additional feature of novelty in the design.

Therefore, the attempts of the defendant on the basis of the file-history estoppel to limit Patent No. D-143,641 to a bead on the bottom of the V-shaped louver, the use of specular metal and the notches in the upper edges of the cross louvers are without support in said file history. The Patent Office issued the patent because the overall design disclosed was broadly distinguished over the “Challenger” reference.

Defendant contends that Patent No. D-138,990 must be limited to the specific ornamentation on its ends because the V-shaped louver is covered by Patent No. D-143,641. However, the relationship of Patent No. D-138,990 to Patent No. D-143,641 is that of a combination patent to a sub-combination patent. Because the V-shaped louver disclosed in “641” was a design unit in itself, it was separately claimed and patented. However, this did not estop the plaintiff from independently patenting a design of which the V-shaped louver constituted a component part.

No representations to the Patent Office were made in the prosecution of this patent application and it was immediately allowed. The file history of the application cannot, therefore, introduce any limitations but, on the contrary, the patent covers the entire design disclosed.

3. No Limited Construction of the Design Patents in Suit  
Is Required by the Prior Art.

Defendant contends that the presumption of validity attending the grant of the patents in suit is overcome by failure of the Patent Office to cite all the prior art shown in Exhibit I and that the patents must therefore be strictly construed. (Deft. Br. pp. 17-18.)

In the prosecution of both applications the Patent Office cited as a reference the "Challenger 77" fixture, Exhibit 9-H. As may be observed by even a casual inspection thereof, this reference is far closer in appearance to the fixtures pictured in the design patents in suit than is any of the prior art shown in Exhibit I. The trial court found no reference to be more pertinent than the "Challenger 77."

By exhibiting prior art *less pertinent* than that before the Patent Office during the prosecution of the patents in suit, plaintiff cannot destroy or weaken the presumption of validity attending the grant of the patents, and, in fact, such presumption is thereby strengthened.

"The best reference cited by the defendant as the nearest approach to Hibbard was the Maxwell patent. No. 1,089,659 issued to the defendant March 10, 1914. This patent was considered and rejected by the Patent Office in connection with the Hibbard application, thereby strengthening the regular presumption of validity of the Hibbard patent. *Smokador Mfg. Co. v. Tubular Products Co.* (C. C. A.), 31 F. (2d) 255, 257; *Elkon Works v. Welworth Automotive Corporation* (D. C.), 25 F. (2d) 968, 970."

*Electric Machinery Mfg. Co. v. General Electric Co.*, 13 Fed. Supp. 940, 942 (D. C., S. D. N. Y.) (1936). (Modified and affirmed, 88 F. 2d 11, C. C. A. 2, 1937.)

**B. It Is Unfair Competition to Copy the Appearance of an Article Not Dictated and Frozen by Mechanical and Use Requirements Where Such Appearance Has Acquired a Secondary Meaning.**

Although it is a general rule of law that anyone may, without liability, copy features of appearance of an unpatented article which are dictated solely by mechanical or use requirements, features of appearance in the form, structure or general arrangement of an article which are not dictated and frozen in their precise form by mechanical and use requirements, but which are selected to and do render it attractive and distinguishable from other like articles, are subject to a different rule.

In such cases, where the article is identified as to its source by its general appearance of form, shape, and general arrangement of parts, the courts have long condemned the copying as unfair as indicated by the decisions cited in Plaintiff-Appellant's Opening Brief, pages 35-42. The rationale of the rule is simple: whereas appearance features, required to be in the form presented by the use of the device and its commercial acceptance and success, must necessarily be employed by anyone making a similar unpatented device, appearance features not dictated in the form presented by use are copied without necessity and only for the obvious purpose and with the obvious result of confusion and deception of the buyer.

**1. Defendant Has Duplicated Numerous Features of Plaintiff's Fixture Which Are Not Dictated by Requirements of Use.**

Defendant's brief stresses the point that certain particular elements of any light fixture, such as an inclined side panel, a step-down end, or a louvered bottom, are features related to the usefulness of the device the copy-

ing of which does not constitute unfair competition. In support of this contention are cited several authorities holding that the appropriation of a shape or form which is *required* to be used for utilitarian purposes is not wrongful. (Deft. Br. pp. 22-25.)

This argument does not meet the evidence presented in this case, which proves that defendant not only used numerous so-called decorative features of plaintiff's fixture but duplicated various functional parts down to the last minute detail of dimensions, angles and arrangements, although such dimensions, angles or arrangements were not dictated by the necessity of producing an operative fixture.

It was obviously not utilitarian requirements which caused defendant's fixture to coincide precisely with plaintiff's fixture in cut-off angle, for example, which might have been varied between  $25^{\circ}$  and  $38^{\circ}$  without affecting the utility of the fixture [R. 124-125]; nor was it necessary that the length of both the devices be identically fixed at 48 7/16" to insure utility [R. 126, 278]; nor that the defendant's fixture be of exactly the same overall height or depth as plaintiff's [R. 125, 276-277]. Although both fixtures contained the same number of louvers (13), any number between 8 and 29 might have been employed by defendant without affecting utility [R. 125-126].

No less condemned by the courts as unfair competition is the duplication of the appearance features of a device which serve a useful purpose, rather than the purely decorative features, where, as in the instant case, such *useful appearance features might have been varied over a wide choice of dimensions without affecting the utility of the accused structure.*

In *Luminous Unit Co. v. R. Williamson & Co.*, 241 Fed. 265 at 269 (D. C. Ill. 1917), affirmed 245 Fed. 988 (C. C. A. 7, 1917), which case also involved copying of a light fixture, the Court stated:

“ . . . Defendant tried to find an equivalent form which would not so closely resemble the other, but, finding it difficult to do this in respect to the canopy, concluded to adopt the device as a whole. The *exact shape* of the bowl is not *functional*, nor its *markings*, nor the *number and style of hangers*, . . . Defendant could have so changed its device as to avoid this confusion, without interfering with economic, structural, or functional requirements, because there is nothing in the shape of the bowl which is essential. This is a clear case of implied or circumstantial proof of misrepresentation of origin. . . .”  
(Emphasis added.)

See also:

*Thayer Telkee Corporation v. Davenport-Taylor Mfg. Co.*, 46 F. 2d 559 (D. C., N. Y., 1930) (Pltf-App. Op. Br. p. 39);

*McGill Mfg. Co. v. Leviton Mfg. Co.*, 43 F. 2d 607 (D. C., N. Y., 1930) (Pltf-App. Op. Br. pp. 37-39).

## 2. The Appearance Features of Plaintiff's Fixture Have Acquired a Secondary Meaning.

Defendant asserts in its brief that no secondary meaning is established because no *direct* evidence of association by customers with plaintiff's name was adduced. (Pltf.-App. Op. Br. p. 27.) The trial court's Finding of Fact No. 12 [R. 29] is apparently based on the erroneous assumption that secondary meaning is established only by direct testimony of customers and the uncontroverted in-



direct proof thereof is disregarded. Actually, plaintiff's indirect proof of secondary meaning is far more persuasive than would be the testimony of such customers as might have been called upon by both sides, in endless array, to testify to their association or lack of association of plaintiff's name with the distinctive appearance of its product.

That secondary meaning may be established as a result of such indirect evidence as extensive advertising, sales and long usage has been frequently held by the courts and writers in the field of unfair competition. For example, see:

*Nims on Unfair Competition & Trademarks*, 4th Ed., Sec. 344, pages 1038-1040;

*Wisconsin Electric Co. v. Dumore Co.*, 35 F. 2d 555 (C. C. A. 6, 1929);

*Pro-phy-lac-tic Brush Co. v. Abraham & Straus*, 11 Fed. Supp. 660 (D. C., N. Y., 1935);

*F. W. Fitch Co. v. Camille*, 106 F. 2d 635 (C. C. A. 8, 1939);

*Shaler Co. v. Rite-Way Products, Inc.*, 107 F. 2d 82 (C. C. A. 6, 1939);

*General Shoe Corporation v. Rosen*, 111 F. 2d 95 (C. C. A. 4, 1940);

*Prince Matchabelli, Inc., v. Anhalt & Co., Inc.*, 40 Fed. Supp. 848 (D. C., N. Y., 1941).

In the last-cited case, wherein the facts appear quite similar to those of the instant case, the Court stated, page 850:

“ . . . The affidavits of the plaintiff show that the plaintiff has been engaged for more than fifteen years in the manufacture and sale of perfumes, cosmetics and related articles, such as compacts, purse

kits and the like; these articles have been put out by the plaintiff in a distinctive way so as to show their origin, and have been extensively advertised; they have always borne the name and mark of the plaintiff, and have become identified by the public as the plaintiff's product. It is also stated in the affidavits that approximately \$50,000.00 has been spent for advertising and promoting the purse kit of the patent, and that 282,732 of the purse kits have been sold at \$1 each, representing a retail sales value of \$282,732. None of these facts has been questioned or denied in the affidavits submitted by the defendant. . . .

"I think it is plain from the record now before me that the purse kit of the patent has 'become so associated with the plaintiff in the mind of the public as to acquire a secondary meaning and cause any bag of the same appearance to be ascribed to the plaintiff as the source of production.' . . ."

**3. No Proof of Actual Confusion or Damages to Plaintiff Need Be Presented to Establish Unfair Competition.**

Defendant in its brief stresses the fact that plaintiff has failed to show proof of actual deception or palming off. (Pltf.-App. Op. Br. pp. 33, 39.) This Court, as well as numerous California decisions, has held *the mere likelihood of confusion or damage to plaintiff is sufficient.*

*Stork Restaurant, Inc., v. Sahati*, 166 F. 2d 348 (C. C. A. 9, 1948);

*Sun-Maid Raisin Growers v. Mosesian*, 84 Cal. App. 485, 258 Pac. 630;

*California Prune & Apricot Growers Association v. Nicholson*, 69 Cal. App. 2d 207, 65 U. S. P. Q. 533;

*Winfield v. Charles*, 77 Cal. App. 2d 64, 175 P. 2d 69.



In the *Winfield* case the Court stated the rule in unfair competition cases as follows:

“*It is unnecessary*, in such an action, to show that any person has been confused or deceived. It is the likelihood of *deception* which the remedy may be invoked to prevent.” (Emphasis added.)

### C. Defendant Has Not Established Any Special Circumstances Entitling It to Attorneys’ Fees.

Defendant in its brief attempts to enumerate several circumstances which it alleges justify the Court in awarding attorneys’ fees to it. These are a far cry from the type of finding which this Court recently indicated might justify such an award in *Dubil v. Rayford Camp & Co.*, 87 U. S. P. Q. 143, namely, fraud in the inducement of the patent or unreasonable prolongation of the trial.

Defendant’s principal contention is that non-infringement should have been apparent to plaintiff’s counsel (Pltf.-App. Op. Br. p. 43), so they should never have brought the suit in the first instance, *i. e.*, the action was unjustifiably commenced. This argument is obviously specious, patent infringement being almost always a question which is wide open to an honest difference of opinion.

Plaintiff’s conduct in charging infringement of a third patent, No. 2,411,952, and failing to sue thereon (Deft. Br. p. 41) shows a restraint in bringing to the trial claims which plaintiff felt might not be fully substantiated. Undue prolongation of the trial was actually avoided by plaintiff in suing under the design patents only.

The fact that depositions were taken by plaintiff and not introduced into evidence (Pltf.-App. Op. Br. p. 41) is not reprehensible conduct on the part of plaintiff, since

the depositions were taken as provided by the Federal Rules of Civil Procedure for discovery purposes and not for use as evidence at the trial. The amendment of the complaint to introduce the unfair competition count, which defendant emphasizes was made after the close of plaintiff's *prima facie* case (Deft. Br. pp. 41-42), did not prolong the proceedings but merely conformed the pleadings to the proof.

In short, defendant cannot point to any facts regarding defendant's conduct throughout this litigation which justifies a holding of "special circumstances" and the trial court made no findings of fact whatsoever to support the same. The trial court obviously felt that attorneys' fees should be given to the prevailing party in any patent suit, and irrespective of the fact that the equities lay with the losing party, and thereupon awarded a substantial sum to defendant as a matter of course. It is submitted that in making such award the trial court clearly abused its discretion.

#### **D. Conclusion.**

Defendant does not attempt to disprove the fact that the accused device and the device of the patents are indistinguishable except in minute detail, on very close scrutiny. Instead, defendant seeks to place unwarranted limitations on the patents in suit in an effort to nullify completely the protection afforded under the Patent Laws to new, original and ornamental designs.

In addition, defendant has appropriated numerous appearance features of plaintiff's device down to the smallest detail of form and dimension, such features being identified among consumers with plaintiff and its product.

All the equities of this case lie with plaintiff. Merely because defendant has prevailed in the trial court is no basis for penalizing plaintiff by an award of attorneys' fees to defendant.

It is accordingly respectfully submitted that the decision of the trial court should be reversed.

Dated: At Los Angeles, California, this 4th day of January, 1951.

Respectfully submitted,

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